

**REMARKS**

The Office has required restriction in the present application as follows:

- Group I: Claims 1-21 and 24; drawn to a "process for manufacturing a paper," classified in class 162, subclass 206.
- Group II: Claim 22, drawn to a "process for making a coated paper with specific pigments," classified in class 162, subclass 158.
- Group III: Claim 23, drawn to a "Coated Paper," classified in class 428, subclass 341.

Applicants elect, with traverse, Group I, Claims 1-21 and 24; drawn to a process for manufacturing a paper, for further prosecution.

The Office has characterized the inventions of Groups I and II as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that "since the process produce different papers, i.e., the papers produced by group I do not contain the pigments as claimed in group II and therefore, they are physically different". However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.


The Office has characterized the inventions of Groups (I and II) and III are related as process of making and product made. Citing MPEP §806.05(f), the Office concludes that the process as claimed can be used to make other and materially different product. However, there is no evidence of record to show that the claimed process can be used to make a materially different process, such as "one having different grammage as the one claimed and/or a paper without platy kaolin as required by the product" as the Office has alleged. If in fact the claimed process can be used to make "one having different grammage", Applicants

respectfully submit that the Office has not shown that "one having different grammage" are materially different from the claimed product. Applicants respectfully submit that the burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and is not on the Applicants to establish that they are not. Accordingly, the Restriction Requirement is believed to be improper, and it should be withdrawn.

Finally, Applicants respectfully remind the Office that if the Office finds the traversed restriction requirement addressed herein as final and that the claimed process as elected herein as patentable, the Office is compelled to rejoin the claim drawn to the process for making a coated paper with specific pigments and the claim drawn to a coated paper. Early and favorable indication is respectfully requested.

The Applicants further submit that this application is in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Date: November 14, 2005

By: 

Matthew M. Eslami

Reg. No. 45,488

Patent Agent for Applicant

International Paper Company

6285 Tri-Ridge Boulevard

Loveland, Ohio 45140

Tel: (513) 248-6193

Fax: (513) 248-6455

e-mail: matt.eslami@ipaper.com